

Office Action Summary	Application No.		Applicant(s)	
	10/726,907		WONG ET AL.	
	Examiner		Art Unit	
	Jason P. Salce		2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6,11 and 13 is/are rejected.
- 7) ☒ Claim(s) 2,4,5,7-10,12 and 14-18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/8/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 2623

DETAILED ACTION***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 3/8/2005 was filed after the filing date of the instant application on 12/3/2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 4, 6-7, 11-12, 14-15 and 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5-6 and 12-16 of copending Application No. 10/426,109. Although the conflicting

Art Unit: 2623

claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broader than the '543 application claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Referring to claim 1 of the instant application, see claim 1 of the '543 application. Note that both claims contain a first and second register, determining a maximum number of channels that can be received by an interface connected to the system (router), and storing the number in the first register. Both applications further contain determining a current number of different channels that are being received by the interface, and stores the current number in the second register. Both applications further contain detecting a channel change request/new channel message from a set top box connected to the interface, the channel change request/new channel message indicating a change from a first channel to a second channel/new subscribed-to channel. Further note that claim 1 of the instant application contains a state machine connected to the first and second registers and that the state machine performs the determination and detecting steps. The examiner notes that a state machine is inherent to system of claim 1 of the '543 application. Claim 1 of the '543 application recites a means for performing the determining and detecting steps. The examiner notes that the state machine in claim 1 of the instant application is equivalent to the means for recited in claim 1 of the '543 application because the means for performing the determining and

Art Unit: 2623

detecting steps inherently are performed by software and/or hardware, which is representative of a state machine.

Referring to claims 2, 4 and 6-7 of the instant application, see claims 2-3 and 5-6 of the '543 application, respectively.

Referring to claim 11 of the instant application, see claim 12 of the '543 application.

Referring to claim 12 of the instant application, see claim 13 of the '543 application.

Referring to claim 14 of the instant application, see claims 14-15 of the '543 application.

Referring to claim 15 of the instant application, see claim 16 of the '543 application.

Referring to claim 18 of the instant application, see claim 14 of the '543 application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 2623

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 6, 11 and 13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Brooks (U.S. Patent No. 2003/0056217).

Referring to claim 1, Brooks discloses a first and second register and a state machine connected to the first and second registers (**see Figure 4 for a first register in the form of table 'X' 304 and a second register in the form of table N_{PCHX} 306 and further note Figure 3 for controller 112 containing state machine/processor 204**).

Brooks also discloses determining a maximum number of channels that can be received by an interface connected to the system, and stores the maximum number in the first register (**see Paragraph 0025 for column 304 in memory 206 enumerating each program channel X selectable by a subscriber through a set-top terminal, which ranges from 1 to K, therefore a maximum number of channels that can be received is determined and stored in a first register**).

Brooks also discloses determining a current number of different channels that are being sent to the interface, and stores the current number in the second register (**see Paragraph 0028 for step 508 determining the current number of channels that are being sent to the interface (modulator bank) by incrementing the second register/table 306 in assignment table 300 and if the register/table 306 value for channel 1 is zero, then the channel is not currently being sent to the interface (modulator bank), therefore when a channel is requested, controller 112**

Art Unit: 2623

increments channel 1's register/table 306 value to 1 and requests that the channel be sent to the proper modulator bank on a specified carrier). The examiner notes that this clearly teaches that a current number of transmitted channels is determined and stored in a second register.

Brooks also discloses detecting a new channel message from a set top box connected to the interface, the new channel message indicating a new subscribed-to channel (see Paragraph 0026).

Referring to claim 3, Brooks discloses that the state machine further determines whether the set top box is currently receiving a previously subscribed-to channel (see again Paragraph 0026).

Referring to claim 6, Brooks discloses that the set top box is a member of a group (see Figure 1 for set top terminals 128-1 through 128-L being service by a single service area node 126 and therefore every set top terminal under service area node 126 is a group).

Referring to claims 11 and 13, see the rejection of claims 1 and 3, respectively.

Allowable Subject Matter

Claims 2, 4-5, 7-10, 12 and 14-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason P Salce
Primary Examiner
Art Unit 2623

Application/Control Number: 10/726,907

Page 8

Art Unit: 2623

August 29, 2007

JASON SALCE
PRIMARY PATENT EXAMINER

A handwritten signature in black ink, appearing to read "Jason Salce", written over the printed name and title.